



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,420	03/11/1999	ALFRED ALASIA	1455.028	7018

7590 08/25/2005

J Micheal Martinez de Andino Esq  
Hunton & Williams  
Riverfront Plaza  
951 East Byrd Street  
Richmond, VA 23219-4074

EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/267,420

Applicant(s)

ALASIA, ALFRED

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-5, 8, 9, 46 and 49-60 is/are pending in the application.
- 4a) Of the above claim(s) 55-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 8, 9, 46 and 49-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED OFFICE ACTION**

**Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 2, 6, 7, 10-45 and 47 and 48 have been canceled. Claims 49-60 have been added.

***Election/Restriction***

2. This application contains claims 55-60 drawn to an invention nonelected with traverse in Paper No. 2/22/05. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-5, 8, 9, and 46, 49-54 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al (WO 98/15418) in view of Drinkwater et al (WO-9427254).

Taylor et al disclose in Fig. 1-4, a self-authenticating article comprising: a plastic paper substitute (2) which can be in the form of a banknote or travelers checks, or the like having indicia (4) printed on the plastic paper substitute; authenticating means is a decoding lens for revealing encoded hidden indicia (Page 15, lines 7-19) wherein the authenticating area (5) is positionable in juxtaposed relation to the hidden indicia thereby providing instant verification of the authenticity of the article (page 15, lines 17-19) and wherein the decoding lens can be an inlaid preformed lenticular lens (Page 4, line 16).

However, Taylor et al does not disclose wherein lens has a lens frequency corresponding to the predetermined line frequency of the encoded hidden image, wherein the lens is positioned to overlies the printable surface so that encoded, hidden indicia may be viewed; and wherein the plastic paper substitute is selected from the group consisting

of synthetic resin films having a high degree of writability and printability, laminate composite structures including combinations of paper and non-paper materials, latex saturated durable papers, coated polyolefin substrates formed from randomly dispersed and bonded polyolefin filaments, reinforced papers, and combinations thereof.

Drinkwater et al discloses in Fig. 1A-1E, wherein a lenticular lens (3, as stated on Page 7, lines 24-33) has preformed lenticules arrays (Page 22, lines 22-28) which are registered in the same relationship (pitch or frequency) of the scrambled image (2, as stated in Page 7, lines 5-9), wherein the image can be reconstructed, or decoded (Page 22, lines 30-36, Page 6, lines 34-37, and Page 7, lines 1-9).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Taylor et al's article with a lenticular lens having a frequency corresponding with the images frequency to decode the image as taught by Drinkwater et al as an alternative means of authenticating an article and decoding indicia.

In regards to **Claims 46 and 49**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any type of imaged indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of

functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of imaged indicia such as imaged formations or patterns, since applicant has not disclosed the criticality of using line imaged indicia, and the invention would operate equally as well with any type of image formation.

In regards to **Claims 5, 49 and 52**, wherein the hidden image is being formed from a plurality of lines printed with a line frequency that is multiple of the lens frequency; and wherein the lenticular lens is produced by an intaglio engraving process, the patentability of a product does not depend on its method of production. If the product in the product-by process claims is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Therefore, the lens and hidden images can be produced or formed by any desired process.

In regards to **Claims 8 and 53**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the article in any desired material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Therefore, it would have been obvious to construct the plastic paper substitute with any desired components, since applicant has not disclosed the criticality of using particular material components, and invention would function equally as well with any component material.

### ***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Matos, and Cioffi et al disclose similar authenticating articles.

### ***Response to Arguments***

4. Applicant's arguments filed on May 23, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that Taylor could not be combined with Drinkwater et al, since Taylor only deals with the magnification of the image and Drinkwater et al does not, the examiner submits that Drinkwater is now used to disclose a lenticular lens in register having frequency (pitch) that correspond to the hidden indicied image on a substrate in order to decode the image, wherein there is magnification by the decoding lens.

In regards to applicant's argument that the prior art does not disclose the use of a lens having a frequency corresponding to a predetermined line frequency of an encoded image, the examiner submits that Taylor as modified by Drinkwater does indeed disclose the use of a lens having frequency corresponding to the frequency of the hidden image. In regards to hidden

Art Unit: 3722

indicia being comprised of lines having a frequency, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any type of imaged indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of imaged indicia such as imaged formations or patterns, since applicant has not disclosed the criticality of using line imaged indicia, and the invention would operate equally as well with any type of image formation.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

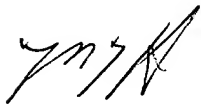
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the



shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Boyer Ashley, can be reached at (571) 272-4502. The formal fax number for TC 3700 is (571) 273-8300.



MTH

August 18, 2005



BOYER D. ASHLEY  
PRIMARY EXAMINER